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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ALANKO, ANITA KAREN

ART UNIT PAPER NUMBER

1765

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/034,233

Applicant(s)

RANGARAJAN ET AL. *RA*

Examiner

Anita K Alanko

Art Unit

1765

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Anita K. Alanko
Anita K Alanko
Primary Examiner
Art Unit: 1765

Continuation of 5. does NOT place the application in condition for allowance because: Applicants arguments are not persuasive. Applicant argues that Ishizaki teaches away from using embedded resistors. In response, the mere mention of a "conventional" apparatus in a patent is an indication of its usefulness. An apparatus would not become conventional if it was not useful. This is not some obscure, unknown apparatus. To the contrary, it is labelled by Ishizaki as a "conventional" apparatus. Conventional means that it is "developed, established or approved by general usage" according to the Webster's II New Riverside University Dictionary. Therefore, resistors embedded in workpieces are useful.

Applicant points out various passages that he argues teach away from using embedded resistors, paragraphs [0010], [0013]. These paragraphs discuss the shortcomings of the prior art, and the advantages of using Ishizaki's invention. All patents necessarily discuss the shortcomings of the prior art and why their invention is better. However, not all prior art is not useful. Not all inventions teach away from using the prior art. Ishizaki is merely one method to improve over the prior art, for specific applications (e.g., according to paragraph [0010] for those workpieces that cannot be processed by using the apparatus of the first type). Ishizaki does not disclose that apparatus of the first type cannot be used at all, and that only Ishizaki's invention works. Ishizaki's invention is better for some types of substrates, but for other types it may not be.

Applicant argues that Ishizaki teaches controlling processing of workpieces through position sensors and information therefrom, Ishizaki does not employ embedded electrical resistance members as recited in the claims. In response, Ishizaki is not relied upon to teach the use of position sensors. Ishizaki teaches that embedded resistors are known and useful. Ishizaki is directed to not only ceramic workpieces, but to various kinds of workpieces [0068]. CMP of semiconductors is not new.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In this application, a person with the knowledge taught by Ishizaki is familiar with electrical resistors and embedding them. Where would they be embedded? In different layers or the same layer? How would they be connected? These questions necessarily arise, and it is obvious to arrange them as cited to one with skill in the art.